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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,847	06/19/2000	RONEN SANDER	MERCK-2114	4887
21884	7590	02/12/2004	EXAMINER	
WELSH & FLAXMAN LLC 2450 CRYSTAL DRIVE SUITE 112 ARLINGTON, VA 22202			PAK, JOHN D	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/581,847

Applicant(s)

SANDER, RONEN

Examiner

JOHN D PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003 and 05 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 and 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 18 and 20-31 are pending in this application. This Office action is in response to applicant's amendments and remarks filed on 7/17/03 and 11/5/03.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18, 20-24 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent method claim 18 has been amended to require two compositions, one comprising at least one pearl luster pigment comprising at least coated mica and another comprising at least one agriculturally acceptable diluent, carrier or adjuvant. The originally filed disclosure does not appear to provide adequate written descriptive support for separate application of the coated mica and a separate application of diluent, carrier or adjuvant. Although the originally filed disclosure and examples therein show the coated mica in combination with diluent, carrier or adjuvant in one composition, their separate use in separate applications has not been originally disclosed. This difference is not trivial, because if the coated mica were applied first, subsequent spraying of the diluent, carrier or adjuvant may dislodge or wash away the

attached coated mica particles. Therefore, such additional application method must have been originally disclosed. For these reasons, the above noted claims lack adequate written descriptive support from the originally filed disclosure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 26 and 29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kieser for the reasons of record.

Applicant's arguments relative hereto have been given due consideration but they were deemed unpersuasive. Applicant argues that one cannot foretell whether Kieser's preparations would be "successful for the purpose of insect repelling," "miscible with acceptable agricultural carriers," or attach to the plants.

The Examiner maintains that he has met his burden of establishing anticipation. See MPEP 2112 and 2112.01. The ingredients in Kieser's preparations would function to provide diluent, carrier or adjuvant properties for the same exact type of coated micas as applicant's coated micas. See Kieser's Examples 1-10 and 12. Because Kieser's compositions contain the same exact ingredients as those encompassed by applicant's claim language, properties present in applicant's composition would necessarily be present in Kieser's compositions. See in particular, MPEP 2112.01, the subsection

entitled, "COMPOSITION CLAIMS – IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES." Additionally, applicant's claim language, "being effective for directly applying and attaching to at least one surface of a growing plant and being suitable for agricultural applications" are clearly met by Kieser's compositions. Kieser's explicitly disclosed compositions contain a variety of additives such as stearic acid (Examples 1-2), myristic acid (Examples 3, 12), ketone resin (Example 4), dibutyl phthalate in combination with an acid (Examples 5-6), lauric acid (Examples 9-10), which are all suitable agricultural diluent, carrier or adjuvant. Given that applicant's "attaching" property is not further defined, the Examiner maintains that Kieser's moisturizing additives would aid in attaching to at least one surface of a growing plant to some extent. In view of the fact that applicant's claims also read on powders, Kieser's preparations are clearly within the metes and bounds of the claimed invention. Therefore, Kieser's explicitly disclosed compositions anticipate the compositions of the above noted claims.

Claims 25-29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Williams for the reasons of record.

Applicant's arguments relative hereto have been given due consideration but they were deemed unpersuasive. With regards to Williams' unstated and undisclosed use for protecting plants from insects and insect transmitting plant viruses, the previous

discussion of MPEP 2112 and 2112.01 in this Office action is hereby incorporated by reference. Because Williams' composition contains the same exact ingredients as those encompassed by applicant's claim language, properties present in applicant's composition would necessarily be present in Williams' composition.

Applicant argues that the inoculum and polymer adhesive in Williams' composition "are harmful to the light reflecting effect of the pigment, because they obscure the pigment." Applicant argues that the pigment of the present invention "must be applied in as transparent as possible carrier, not to diminish its light reflecting properties." The Examiner cannot agree. First, applicant's claims require no such thing – the diluent, carrier or adjuvant has not been further limited to be transparent or "as transparent as possible." Claims are to be interpreted as broadly as reasonable during examination, and applicant is reading a limitation into the claims that is not recited or expressly noted by the disclosure as being critical. There is no indication from the originally filed disclosure that the undissolved mica particles would not function to provide their stated properties when not combined with transparent or near-transparent diluent, carrier or adjuvants. Second, applicant's specification contemplates diluents, carriers or adjuvants that are not "as transparent as possible," such as carbon black (p. 5, line 30), chalk (p. 4, line 20), adhesives (p. 4, line 18) and vegetable oil (p. 4, line 17). Therefore, the Examiner maintains that applicant's claim language does not preclude the additional ingredients present in Williams' composition.

Claims 25-27 and 29-30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ambrosius et al. for the reasons of record.

Applicant's arguments have been given due consideration but they were deemed unpersuasive. Regardless of what Ambrosius et al. intended to do with their composition, it cannot be disputed that they explicitly disclose an aqueous suspension of mica coated with tin dioxide and titanium dioxide (see e.g., Examples 1-8 and claim 1; see also column 1, lines 6-12, column 3, lines 17-19). Ambrosius' explicitly disclosed aqueous suspension of coated mica anticipates the above noted claims. MPEP 2112, 2112.01.

Claims 25-27 and 29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Duschek et al. for the reasons of record.

Applicant's arguments have been given due consideration but they were deemed unpersuasive.

Applicant argues that the Duschek et al. do not regard their aqueous suspension of mica particles in demineralized water as a "useful product." Applicant argues that the aqueous suspension is only a starting material, which is disclosed in a "transient step," for subsequent processing, and thus not given "any autonomous status." This argument is not acceptable. The fact situation here is not one where the substance in question

has not been isolated. Here, the aqueous suspension of the same exact coated micas is expressly disclosed (Example 1, column 7, lines 44-46; Example 2, column 8, lines 49-51). The suspension is not temporary or ephemeral. The suspension exists and is isolated. Therefore, the prior art has explicitly disclosed the now-claimed composition by applicant. See MPEP 2112, 2112.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

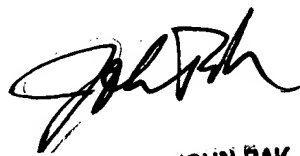


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**, **effective February 3, 2004**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Thurman Page, can be reached on (571)272-0602, effective February 3, 2004.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600